



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. AM100056 D1)

In re Application of:) Appln. No.: 10/618,044
DAN M. BERGER *et al.*) Confirmation No.: 4109
Filed: 07/10/2003) Customer No.: 25291
For: TRICYCLIC PROTEIN) Group Art Unit: 1626
KINASE INHIBITORS) Examiner: Ebenezer O. Sackey
) Paper No.: 8
)

RESPONSE TO A RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the Office communication mailed May 6, 2004 in the above-referenced patent application, please consider the below remarks in a favorable light:

REMARKS

Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

The Examiner requires restriction to one of twelve allegedly different inventions under 35 U.S.C. § 121, which are shown and classified on pages 3 and 4 of the Office action. The Examiner has concluded that restriction for examination purposes is proper because these inventions are allegedly distinct and have acquired a separate status in the art for reasons given on pages 4-10 of the Office action.

Applicants submit that restriction pursuant to 35 U.S.C. § 121 is unwarranted under the circumstances. There is ample justification to keep all of the pending claims and subject matter in this single application. Equitable considerations also justify a withdrawal or, at the very least, a significant modification of the restriction requirement.

Since the Markush group makes sense, the restriction of formula 1 is not necessary under the present circumstances. The basis of the invention, taken as a whole, is unified in light of the novel fully aromatic fused tricyclic compounds containing nicotinonitrile rings and their unique use as inhibitors of the biological effects of protein tyrosine kinase. Contrary to the Examiner's opinion, the compounds share the common utility as protein tyrosine kinase inhibitors and share a substantial structural feature disclosed as being essential to that utility, namely, the substituted